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Appl. No. 09/769,604

JUL 24 2007 Docket No. EMC-002PUS

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the amendments set forth above and the below remarks.

Applicant makes this submission as part of a Request for Continued Examination.

Claims 1-15 and 17-21 are pending in the application. New claim 22 is added.

Claims 1-15 and 17-21 are pending in the application and are rejected under 35 U.S.C. §102(e) over U.S. Patent No. 6,594,677 to Davis et al. U.S. Patent No. 6,594,677 to Davis (hereinafter Davis) was filed on December 22, 2000 and received Application No. 09/747,457. Applicant previously submitted a Rule 1.131 Declaration that the Examiner asserts to be ineffective.

Applicant previously submitted a Declaration under Rule 1.131 in response to the final Office Action mailed on January 24, 2007. The Examiner states in the Advisory Action dated July 18, 2007 that the Rule 1.131 Declaration is "ineffective" on the basis that the "exhibits fail to show any dates and furthermore fail to reflect Applicant's statements in paragraphs 3-6 of the 1.131 declaration." The Examiner also states that the "cumulative statements and exhibits do not contain sufficient disclosure in regards "how to use" and "how to make" the invention, as is [sic] the requirements of 35 U.S.C. 112 first paragraph (see MPEP 2138.05[R-3]." Applicant respectfully submits that the Examiner is off base with respect to these assertions. The Rule 1.131 Declaration submitted by the Applicant establishes *actual reduction to practice* of the claimed invention. There is no requirement that the Rule 1.131 Declaration contain disclosure of "how to use" and "how to make" the invention. It is Applicant's specification that must meet the requirements of §112, which are clearly met as implicitly admitted by the Examiner in each of the eight Actions issued in the present case.

Moreover, Applicant has reviewed all of MPEP §2138.05 at [www.uspto.gov](http://www.uspto.gov). Part I of this MPEP section does note that the requirements of 35 U.S.C. 112, first paragraph, must be met – for

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*constructive reduction to practice*, e.g., a patent application filing. Applicant notes the remaining parts of MPEP 2138.05 discuss the requirements for establishing *actual* reduction to practice. Applicant submits that all of these requirements for an actual reduction to practice are clearly met. As stated in the Rule 1.131 Declaration, the claimed invention, fully understood by the inventors, was contained in a software release made by EMC corporation prior to December 22, 2000. It is clearly documented in the Declaration that the software release contained an actual reduction to practice of the claimed invention prior to December 22, 2000, as evidenced by the release announcement, a listing of source file names, a screen shot showing the software release and source file names comprising the executable file, and a first page of a *source code listing*.

Applicant wishes to make clear the significance of a software release. Well before a software release is planned, technical staff conceptualize, develop, test and retest, over months and years, the program code that will be contained in the release. In the present case, the inventors spent very significant time and energy developing and becoming intimately familiar with the claimed invention. After many tens of thousands of man hours, the software release is provided to customers, here customers of EMC corporation. One can readily appreciate the importance of software releases to EMC's excellent reputation, for example, from the e-mail provided as Exhibit A of the Declaration.

In addition, the Examiner appears to give zero weight to the sworn statements of all four inventors including a statement that, after a listing of exemplary claim 1, at the end of paragraph 2 of the Declaration:

"Functionality for the claimed subject matter was contained in software modules forming a part of a software release prior to December 22, 2000."

With regard to the Examiner's assertion that the "exhibits fail to show any dates," Applicant submits that dates have been redacted from the exhibits in accordance with standard practice. However, as stated in the Declaration, each inventor has sworn that each exhibit provides documentary evidence of actual reduction to practice prior to December 22, 2000. Applicant submits that this meets the requirements of Rule 1.131. Rule 1.131(b) states that:

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"The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained."

Applicant submits that the previously submitted Rule 1.131 Declaration meets these requirements.

In view of the above, Applicant submits that the Rule 1.131 Declaration should be accepted and respectfully requests a notice of allowance for this case.

Should the Examiner maintain that the filed Rule 1.131 is ineffective, Applicant requests that the Examiner contact the undersigned to discuss exactly what the Examiner requires for a Rule 1.131 Declaration. In view of the fact that Applicant has a source listing of the program code for the claimed invention for a software release prior to the relevant date, Applicant believes that any and all issued regarding a further Rule 1.131 Declaration can be readily disposed of.

Consideration for new claim 22 is requested.

The Examiner is respectfully invited to telephone the undersigning attorney if there are any questions regarding this Amendment or this application.

Applicant does not acquiesce to any assertion made by the Examiner that is not specifically addressed herein.

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The Assistant Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment to Deposit Account No. 500845.

Respectfully submitted,

Dated: July 24, 2007

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